UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,261	04/12/2001	John Isaac Chandan Gomes	70006553-3	2747

7590	07/07/2004

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EXAMINER
HANNE, SARA M

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/834,261	GOMES ET AL.
	Examiner	Art Unit
	Sara M Hanne	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 March 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>12 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO-SB/08)
Paper No(s)/Mail Date <u>5/14/04</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment received on 3/24/2004. Claims 1-20 are

pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Nykanen et

al., US Patent 6285889. As in Claims 1,10 and 12 of the application, Nykanen et al.

teaches a process to apply remotely stored information to an appliance using a mobile

device (portable telecommunications device) through a network ("data intended for

outputting is transferred between two telecommunication terminal devices or between a

telecommunication terminal device and an output device", Column 3, lines 10-12) that

sends instructions from the mobile device to a first computer system which routes

information to the appropriate appliance (Column 3, lines 39-43). The process is done

by designating which piece of remote information to be processed in the instructions in

the mobile device, retrieving that information and converting it to a format suitable for

the appliance and applying that information to the appliance according to the

instructions (Column 3, lines 26-34).

As in Claim 2, Nykanen et al. teaches several appliances connected through the first computer system, the appliances designated by the mobile device in the instructions (Figure 1 and Column 5, lines 29-30).

As in Claim 3, Nykanen et al. teaches the appliances registered with the first computer system (Column 3, lines 50-55).

As in Claim 4, Nykanen et al. teaches the appliances designated by the mobile device in the instructions through a specified appliance identity (the printer identity must be known to distinguish between the available printers, Column 5, lines 29-30, Column 2, Lines 50-54).

As in Claims 5 and 11 of the application, Nykanen et al. teaches the mobile device designating the information to be sent by including it's location in the instructions (Column 3, lines 41-46).

As in Claim 6 of the application, Nykanen et al. teaches a gateway, such as the Internet Service Provider used to connect the user to the Internet, included in the first network, which communicates with the mobile device using Standard Telecommunications Protocols (Column 6, lines 41-64) where the gateway converts the instructions to a format compatible with the first computer system (when accessing the information through the Internet, gateways operate as such).

As in Claims 7 and 14, Nykanen et al. teaches the information stored in a second computer system (the Internet service, Column 6).

As in Claims 8 and 13, Nykanen et al. teaches the appliance as a printer, and the first computer system converts the first piece of information to a print job in a format

suitable for printing. (when the file is reformatted before it is sent to the printer, it is formatted to be a print job).

As in Claim 9, Nykanen et al. teaches the first computer system converts the first piece of information to a PDL format for printing (Column 11, lines 26-36 and Column 13, lines 5-9).

As in Claim 15, Nykanen et al. teaches a mobile device initiated process for transferring information stored outside of the mobile device (the Internet) to an appliance for processing thereon, comprising: forming an information transfer instruction on the mobile device, wherein the instruction comprises an identifier that identifies the information and an appliance identifier of the appliance (See Claim 5 rejection *supra*), sending the instruction to a computer system, retrieving the information based on the information identifier, and forwarding the information to the appliance identified by the appliance identifier (Column 3, lines 50-55).

As in Claim 16, Nykanen et al. teaches retrieving the information comprises: obtaining the location where the information is stored based on the information identifier, and retrieving the information from the location (See Claim 5 rejection *supra*).

As in Claim 17, Nykanen et al. teaches registering the information and the location where the information is stored with the computer system (websites are registered in order to be posted through the Internet and the location where the information is stored is the web address).

As in Claim 18, Nykanen et al. teaches registering an identifier of the owner of the information with the computer system (the owner is the location of the site), and

wherein the information transfer instruction further comprises the owner identifier (the URL, also Claim 7 and Column 1, lines 45-49).

As in Claim 19, Nykanen et al. inherently teaches requesting the computer system to provide information identifiers associated with a particular owner (request internet address), and wherein the information for transfer is selected from the information identifiers (URL).

As in Claim 20, Nykanen et al. teaches the information identifier comprises a uniform resource locator (URL) and retrieving the information comprises downloading information from the Internet using the URL (See Claim 18 rejection *supra*).

Response to Arguments

4. Applicant's arguments, see Pages 6-12, filed 3/24/2004, with respect to the rejection(s)of claim(s) 1-14 under 102(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nykanen et al., US Patent 6285889 as seen *supra*.
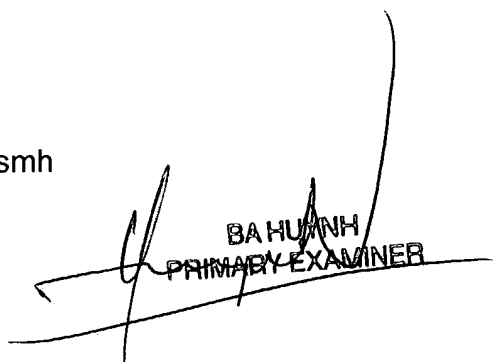
Conclusion

5. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar remote control systems for devices and remote accessing methods.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

smh

BA HUYNH
PRIMARY EXAMINER